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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/761,099

01/21/2004

Hideo Miyake

Q79454

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23373

7590

10/27/2006

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EXAMINER

SCHILLING, RICHARD L

ART UNIT

PAPER NUMBER

1752

DATE MAILED: 10/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/761,099

Applicant(s)

MIYAKE ET AL.

Examiner

Richard L. Schilling

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 26 July 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-81,85-87,92-97 and 99-128 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-48,76-81,92-97 and 99 is/are allowed.
- 6) ☒ Claim(s) 49-75,85-87 and 100-128 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>7-26-06</u> . | 6) <input type="checkbox"/> Other: _____  |

1. Claims 49-75, 85-87 and 100-128 are rejected under 35 U.S.C. 251 as being based upon new matter added to the patent for which reissue is sought for the same reasons as set forth in paragraph 2 of the first office action filed 1-26-06. Also new claim 128 contains new matter since the cyanine dyes for layer B are only disclosed in the specification and original patent as infrared absorbing dyes for generating heat. Adding the requirement that the polymers contain a monomer that reduces plate wear does not require the particular monomers listed in the specification as having that property. The original patent is limited to copolymers with at least 10% of at least one monomer of formulas a-1 to a-3 in layer A. The portion of the patent referred to by applicants, i.e. col.6, lines 6-20, requires copolymers with one of a-1 to a-3 to improve plate wear and sensitivity. Monomers of a-1 to a-3 are not disclosed as optional comonomers in the polymers of layer A anywhere in the original patent. The presence of the compound that absorbs light to generate heat in Layer B is not disclosed as optional or preferred in the patent but rather as necessary and is directed to the disclosed advantage of using layer A to reduce heat generated in layer B from dispersing into the substrate( see col. 4, lines 19-49 ). The concept and advantages of the disclosed invention covered by the instant claims is the presence of underlayer A so that heat generated by the light absorber in layer B does not disperse into the substrate. While the location of the light absorber in layer B and copolymers with monomers a-1 to a-3 are disclosed under the heading "Description Of The Preferred Embodiments " in the patent as argued by applicants, broader descriptions supporting other alternatives are not found elsewhere in the patent, including the summary of invention or claims.

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2. Claims 49-75, 85-87 and 100-128 are rejected under the first paragraph of 35 USC 112 as failing to comply with the written description requirement for containing subject matter as identified in paragraph 1 not supported by the specification.

3. Claims 49, 50, 53-55, 85-87, 100, 101, 111, 112, 115, 116, 119, 120, 123, 124 and 127 are rejected under 35 U.S.C. 102(b) as being anticipated by Van Damme et al.'502 for the same reasons as set forth in paragraph 7 of the first office action.

4. Claims 51, 52, 56-75, 102-105, 110, 113, 117, 118, 121, 122, 125, 126 and 128 are rejected under 35 U.S.C. 103(a) as being unpatentable over Van Damme et al.'502 in view of Kawamura et al.'123 and Parsons et al. for the same reasons as set forth in paragraph 8 of the first office action.

5. Claims 49, 50, 54, 58-61 and 64-67 rejected under 35 U.S.C. 102(b) as being anticipated by West et al.'222 for the same reasons as set forth in paragraph 9 of the first office action.

6. Applicant's arguments filed 7-26-06 have been fully considered but they are not persuasive. The new matter arguments are answered in paragraph 1 above. The monomer that reduces plate wear is not specified in the instant claims to distinguish over the underlayer polymers containing monomers of West et al. or Van Damme et al. The alkali soluble copolymer underlayers of West et al. and Van Damme et al. would inherently, at least to some extent, reduce heat dispersion into their substrates from heat generated by light absorbers in their upper layers which is the disclosed ( col. 4 ) function of the copolymer underlayers A of the instant claims. The underlayer copolymers of Van Damme et al. and West et al. contain aqueous alkali soluble

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comonomers. The intermediate layers of Van Damme et al. and the photosensitive underlayers of West et al contain monomers, e.g. acrylic acid and OH containing in Van Damme et al. and amide and phosphonic acid in West et al., that provide alkali solubility as set forth in applicants' patent at col. 6, lines 13-20.

7. The prior art cited by applicants has been considered.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication should be directed to Richard L. Schilling at telephone number 571-272-1335.

RICHARD L. SCHILLING  
PRIMARY EXAMINER  
GROUP 1100

